

REMARKS

Claims 1-10 and 12-14 are pending. Claims 1 and 12 have been amended. No new matter is presented.

Claims 1 and 12 were objected to due to an informality. This informality has been corrected. Therefore, Applicants request that this objection be withdrawn.

Claims 1, 2, 4 and 14 were rejected under 35 U.S.C. 102(b) as being anticipated by Clark (U.S. Patent No. 4,966,644). This rejection is respectfully traversed.

Claim 1 recites "a marker and sheet feeder for synchronously feeding the marker and the predetermined sheet in a partially overlapping position." In other words, the sheet and the marker are fed at the same time (see specification page 3, line 1). Claim 1 also recites "the marker is adhered to the predetermined sheet by a predetermined pressure force as the predetermined sheet passes through the marker and sheet feeder without pausing the marker and sheet feeder." Thus, there is no pause in the feeding of the sheets to add markers between the groups, thus saving time. Neither of these features are taught or suggested by Clark.

Clark does not teach that the sheet and the marker are fed at the same time. Clark discloses that the supply paper 13 is fed through rollers 70 and 71 after the photosensor 118 causes the control circuitry 110 to activate the supply paper roller motor 73 which rotates the supply paper advance roller 70 (col. 8, lines 38-41). Further, according to Clark, the advancement of the supply paper leading edge is stopped (col. 8, lines 47-48).

Claim 1 also recites that "the pair of feeding means is positioned in contact with each other when the marker is adhered to the predetermined sheet, and separated from each other when sheets not receiving a marker are fed." Claim 1 has been amended to clarify that the pair

of feeding means is positioned apart when a sheet which is not receiving a marker is fed. Clark does not teach or suggest this feature.

The Examiner asserted that Clark teaches that the pair of feeding means 108/109 can be either in contact with each other or apart from each other (referring to col. 7, lines 63 through col. 8, line 3). However, Clark actually states that sealing roller 108 radially and resiliently abuts or almost touches a sealing idler roller 109. However, Clark does not disclose changing the respective position of the pair of feeding means. Clark also fails to disclose that the feeding means is positioned together when the marker is to be adhered and apart when a sheet is being fed without receiving a marker. There is no teaching in Clark which suggests that the pair of feeding means come together or move apart except in a slight manner to accommodate the thickness of the sheet being fed. Elements 108 and 109 may turn in a radial direction but are otherwise basically fixed. Thus, Clark fails to teach or suggest the features of claim 1.

Claims 2, 4 and 14 are allowable at least due to their dependency from claim 1.

Applicants request that this rejection be withdrawn.

Claims 12 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Applicants' admitted prior art. This rejection is respectfully traversed.

Claim 12 recites all of the features discussed above in conjunction with claim 1. Clark fails to teach or suggest these features and the prior art discussion in this application also fails to teach or suggest these features. Thus, claim 12 is allowable in light of the above arguments.

Claim 13 is allowable at least due to its dependency from claim 12. Applicants request that this rejection be withdrawn.

Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over Clark as applied to claims 1, 2, 4 and 14 above, and further in view of Vonderhorst et al. (U.S. Patent No. 5,556,492). This rejection is respectfully traversed in light of the above remarks specifically pointing out that Clark does not teach that which is asserted by the Examiner. Applicants request that this rejection be withdrawn.

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Clark as applied to claims 1, 2, 4 and 14 above and further in view of Nobile (U.S. Patent No. 5,390,594). This rejection is respectfully traversed in light of the above remarks specifically pointing out that Clark does not teach that which is asserted by the Examiner. Applicants request that this rejection be withdrawn.

Claims 1, 2, 4, 7, 8 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Busk (U.S. Patent No. 3,245,859) in view of Lowe (U.S. Patent No. 3,926,713). This rejection is respectfully traversed.

Busk and Lowe fail to teach or suggest the above mentioned features of claim 1. Specifically, Busk does not teach or suggest that the sheet and the marker are fed at the same time and that the apparatus does not stop. Lowe is not being relied upon as teaching these features, and, Lowe does not in any event teach or suggest these features.

The Examiner also admits that Busk does not teach or suggest that the pair of feed rollers make contact with each other when the marker is adhered to predetermined sheet and are separated from each other when sheets not receiving a marker are fed. The Examiner states that the discussion with respect to Clark applies in this rejection. However, Clark is not being relied upon in this rejection. In any case, as discussed above, Clark does not teach or suggest this

feature. Lowe also fails to disclose or suggest this feature. Thus, the cited prior art references, including Clark, fail to teach or suggest this feature, either alone or in combination.

The Examiner also asserted that it would have been obvious to have provided in Busk that the pairs of feed rollers make contact when the marker is adhered and separate when the marker is not being applied to allow for different thicknesses to pass therethrough. However, this is not what is claimed. The rollers come apart when a sheet is being passed therethrough when that sheet is not intended to receive a marker. None of the prior art references teaches or suggests this feature. In fact, according to the teaching in Clark, the only time the thickness of the sheet and marker combination would necessitate the rollers separating would be when the marker is being adhered to the sheet. This is the opposite of what is being claimed in claim 1. Accordingly, Applicants request that this rejection be withdrawn.

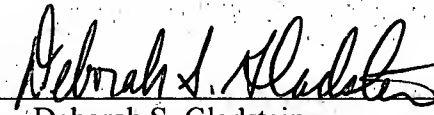
The remaining rejections of claims 3, 5, 6, 9, 10 are respectfully traversed in light of the above remarks specifically pointing out that Busk and Lowe do not teach that which is asserted by the Examiner. Accordingly, Applicants request that these rejections be withdrawn.

Attached hereto is a marked-up version of the changes made by this amendment, captioned "**Version with markings to show changes made**".

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 163852016000.

Dated: September 13, 2002

Respectfully submitted,

By: 
Deborah S. Gladstein
Registration No. 43,636

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 300
McLean, Virginia 22102
Telephone: (703) 760-7753
Facsimile: (703) 760-7777

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Amend claims 1 and 12 to read as follows:

1. (Four Times Amended) A sheet sorting apparatus for adhering a marker to each predetermined sheet of a group of sheets being output by an image processing apparatus [for separating multiple groups of sheets being output into separate groups], comprising:

a tape feeder for pulling out a tape having a pressure sensitive adhesive on one side edge;

a cutter for making the marker by cutting the tape at a preset length;

a guide for positioning the marker at a predetermined position on the predetermined sheet; and

a marker and sheet feeder for synchronously feeding the marker and the predetermined sheet in a partially overlapping position,

wherein the marker and [the] sheet feeder¹⁵ are formed as a pair of feeding means for positioning in contact with and/or separate from each other;

the marker is adhered to the predetermined sheet by a predetermined pressure force as the predetermined sheet passes through the marker and sheet feeder without pausing the marker and sheet feeder, and

the pair of feeding means is positioned in contact with each other when the marker is adhered to the predetermined sheet, and separated from each other when [the adhering of the marker is not needed] sheets not receiving a marker are fed.

12. (Four Times Amended) An image processing apparatus comprising a sheet sorting apparatus for adhering a marker to each predetermined sheet of a group of sheets discharged from the image processing apparatus [for separating multiple groups of sheets being output into separate groups], the sheet sorting apparatus comprising:

a tape feeder for pulling out a tape having a pressure sensitive adhesive on one side edge;
a guide for positioning the marker at a predetermined position on the predetermined sheet; and

a marker and sheet feeder for synchronously feeding the marker and the predetermined sheet in a partially overlapping position,

wherein the marker and [the] sheet feeder are formed as a pair of feeding means for positioning in contact with and/or separate from each other,

the marker is adhered to the predetermined sheet by a predetermined pressure force as the predetermined sheet passes through the marker and sheet feeder without pausing the marker and sheet feeder, and

the pair of feeding means is positioned in contact[ing] with each other when the marker is adhered to the predetermined sheet and in separating each other when [the adhering of the marker is not needed] sheets not receiving a marker are fed.